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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
Sylvia MONSHEIMER, et al.

GROUP: 1734

SERIAL NO: 10/826,334

EXAMINER: Sells, J.D.

FILED: April 19, 2004

FOR: THE ULTRASOUND WELDING OF PLASTICS COMPONENTS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005. This request is being filed with a Notice of Appeal.

REMARKS

In the outstanding Office Action mailed July 25, 2005, Claims 1-2 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarnay et al. (U.S. Patent No. 4,655,486, Tarnay) in view of Parmann (U.S. Patent No. 3,929,958) Claims 3, 4, and 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarnay in view of Parmann and in further view of Flepp (U.S. Patent No. 6, 555,243).

The above-noted rejection of Claims 1, 2, and 5 relies upon the Tarnay bare suggestion of using “ultrasonic welding” (noted at col. 4, lines 28-31 as a possible alternative assembly technique to the preferred snapping together technique of col. 4, lines 15- 27 of Tarnay) as teaching the Claim 1 required use of “sound waves which act longitudinally with respect to a plastics pipe axis” and the Claim 1 required “maintaining an arrangement of areas to be welded substantially parallel to the

plastics pipe axis” (emphasis added). However, no such subject matter is taught or suggested by Tarnay.

Even though this lack of any evidence as to these particular Claim 1 limitations was pointed out in the response filed September 21, 2005, the Advisory Action mailed October 3, 2005, does not explain where in Tarnay, or Parmann for that matter, these teachings can be found. Instead, the Advisory Action simply offers the unsupported opinion that “the examiner believes the applied references teach or make obvious all of applicant’s claim limitations.”

The case law requires more than expressing such beliefs, it requires the PTO to point out where the teaching or suggestion relied on appears in the reference. *See In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference”). Further note *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) prohibiting the use of “conclusory statements” based only “on subjective belief and unknown authority” instead of the required showing of substantial evidence.

In addition, the last paragraph at the bottom of page 1 of the Action mailed July 25, 2005, admits that there is no suggestion in Tarnay of the Claim 1 required “forcing insertion of the coupling end portion into the plastics pipe so that the coupling end portion is inserted inside of and widens the plastics pipe.” The outstanding Action turns to Parmann to teach such pipe widening. However, the outstanding Action has ignored that in addition to this pipe widening by insertion of the coupling end, Claim 1 further requires that during this step insertion, there must be “at least some part of the time that the sound waves are being provided during the ultrasonic welding step.”

The above-noted lack of any particulars in Tarnay as to any ultrasonic welding steps extends to the complete lack of any suggestion that sound waves should be applied while the two members to be welded are being joined. Parmann includes no teachings or suggestions of any ultrasonic welding steps, and no suggestion that

sound waves should be present when the pipe end is inserted instead of after insertion is completed, for example.

In order to establish a *prima facie* case of obviousness, the examiner must show that every claim limitation is taught or suggested by the prior art. See MPEP § 2143.03. Accordingly, as the outstanding Action fails to demonstrate how the relied upon references (Tarnay and/or Parmann) teach or suggest all of the above-noted limitations of Claim 1 (requiring use of “sound waves which act longitudinally with respect to a plastics pipe axis,” requiring “maintaining an arrangement of areas to be welded substantially parallel to the plastics pipe axis,” and “forcing insertion of the other plastics part into the plastics pipe in such a way that there is at least some overlap between exposure to the sound waves and the forced insertion during the ultrasound welding step”) there has been no establishment of a *prima facie* case of obviousness and the rejection should be withdrawn.

Moreover, the outstanding Action never addresses why the artisan would have even considered the pipe socket forming teachings of Parmann to be relevant to the merely suggested ultrasonic welding of connector members 24 and 26 of Tarnay. In this regard, the joining of the connector members 24 and 26 of Tarnay have nothing to do with joining together pipes by simply pushing an insert end of one pipe section into the socket end of the next pipe section as described at col. 1, lines 53- 61 of Parmann. Accordingly, this rejection should also be withdrawn because there has been no presentation of a reasonable explanation why the artisan would have considered selecting such disparate references for combination, much less a reasonable and full explanation of the motivation that would have suggested the modification of Tarnay based on the incompatible teachings of Parmann. Note again *Lee*, and its further requirement for the PTO to “explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious.”

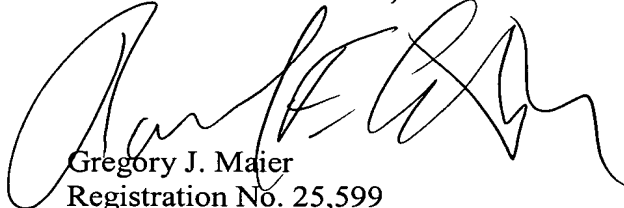
As Claims 2 and 5 depend on Claim 1, the rejection of these claims is clearly improper for all the reasons noted above as to parent Claim 1 and should also be withdrawn.

Turning to the above-noted rejection of Claim 3, 4, and 6-10 that adds Flepp, it is noted that Flepp cures none of the deficiencies set forth above as to Tarnay and Parmann. As each of Claims 3, 4, and 6-10 ultimately depends on Claim 1, the rejection of these claims that include all the subject matter of Claim 1 is clearly improper for all the reasons noted above as to parent Claim 1 and should, therefore, also be withdrawn.

Based on the above-noted deficiencies in the outstanding Action mailed July 25, 2005, Applicants note that there are no actual issues for appeal and respectfully submit that the application should be allowed based upon existing Claims 1-10.

Respectfully Submitted,

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